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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,791	10/27/2000	Gregory L. Slaughter	5181-6500	6698

7590 01/31/2007  
ATTEN: ROBERT C. KOWERT  
CONLEY, ROSE, & TAYON, P.C.  
P.O. BOX 398  
AUSTIN, TX 78767-0398

EXAMINER
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CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

09/698,791

Applicant(s)

SLAUGHTER ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters; prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/11/05.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This action is responsive to the paper(s) filed 5/28/04.

#### ***Request For Information Under Rule 105***

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

■ Applicant has stated that the instant invention (09/698,791) claims benefit of priority to five provisional applications with various filing dates. These 5 provisional applications encompass a total of over 1100 pages of disclosure making it difficult for the examiner to determine the earliest effective dates for each of the 52 claims presented herein. Therefore, an effective and thorough date-based search of the prior art is difficult to perform at this time without undue burden. Applicant is requested to indicate which claims (if any) are *entirely* supported by application(s) filed prior to the filing date of this case. Further, for each such indicated claim (if any), applicant should specify the oldest application which by itself fully supports such claim by noting the application number, filing date, specification page and specification line number. In this manner, examiner can easily determine the earliest supported filing date for each claim. If all claims include a feature that appears only in the instant disclosure, then applicant should state that all claims are entirely supported by an earliest filing date of 10/27/2000 (the filing of 09/698,791). These indications of earliest supporting filing dates for each

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claim will in no way affect applicant's ability to swear behind via 132 declaration any reference(s) that may be applied in an art rejection.

■ Applicant has stated the prior existence of the Jini technology which although described as having limitations desired to be overcome, appears to read on most if not all of the present claims. As Jini is apparently a Sun development, it is unclear what Jini features/versions are prior art to this application. It is requested that applicant disclose to the examiner the state of any Jini technology (or Jini precursors) that existed at the time of 1 year prior to applicant's earliest benefit date(s) as determined above.

Applicant may cite additional Jini materials or may simply direct the examiner towards particular references already presented in the volume of references cited to date by applicant (and examiner).

### ***Claim Objections***

1. Claim 39 is objected to because of the following informalities:

- Claim 39 line 24, "there" should be replaced by --their--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1, 9-21, 26-29, 35-45, 50-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

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- Claims 1, 9-21, 26-29, 35-45, 50-52 fail to provide a concrete, useful and tangible result. Specifically a discovery request and response indicating presence of a service fails to provide a tangible result unless the client accesses the service/space.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-4, 7-18, 20-24, 26-32, 35-42, 44-48, 50-52 are rejected under 35**

**U.S.C. 102(a and/or b) as being anticipated by cswl.com – upnp-devices ("UPnP, Jini**

and Salutation - A look at some popular coordination frameworks for future networked devices", June 1999

whitepaper, <http://cswl.com/whitepapers/upnp-devices.html>).

Regarding claims 1, 2, 7, 10, 13, 14, 16, 17, 20-22, 29, 30, 36, 39-41, 44-46, cswl.com – upnp-devices teaches several device discovery techniques including Universal Plug and Play (upnp) which uses SSDP for enabling devices on a network to announce their presence to the network as well as discover available devices. This can be done by communication through specially formatted messaging with a lookup service. A service (space) that joins the network announces its presence and registers itself (a URI and an XML file describing its abilities) with the lookup service. A client

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thereafter looking to discover available services makes an OPTIONS request query which is detected by the lookup service (listening agent) which responds with an indication (advertisement) representing a matched service/space. The device can then access the service/space if desired. The identification/advertisement of a matching service (space) discovered by way of the lookup service (listening agent) provides information (URI, XML capabilities/description) for accessing the corresponding service/space. The service's API provides an interface information for accessing the service/content therein.

Regarding claims 3, 4, 8, 9, 11, 12, 23, 24, 26-28, 31, 32, 35, 37, 38, 47, 48, 50-52, the advertisement/notification of the uniquely formed/formatted address for the space provides information for sending messages and accessing to the space.

Regarding claim 15, 18, 42, the discovery request can include query options for specific types of spaces using the URI such as "/ietf/ipp/printer" in order to discover such printers.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 6, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over cswl.com – upnp-devices .**

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Regarding claim 6, 34, it would have been obvious to have notified a client accessing a multifunction printer of the abilities/services for FAXing as well as printing, for example so that a client can fully use the services available.

**Claims 5, 19, 25, 33, 43, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over cswl.com – upnp-devices in view of ssdp-v1-03 (Simple Service Discovery Protocol/1.0 – Operating without an Arbiter - <draft-cai-ssdp-v1-03.txt>, October 28, 1999).**

Regarding claim 5, 25, 33, 49, cswl.com - upnp-devices describes the use of XML for communicating the service's capabilities to the lookup directory and interested clients. ssdp-v1-03 describes (4.3.2, 4.3.4) the idea of using XML for better/future implementation and it would have been obvious to have provided any well known schema such as XML in order to communicate between network entities for sharing information/requests.

Regarding claim 19, 43, the SSDP protocol is described as using TCP/IP protocols which are used on the Internet. The search provided by the SSDP discovery requests can be therefore considered to be done by Internet search engine (lookup service). Further ssdp-v1-03 (2.3.1.2) contemplates the use of an Internet search engine which would have been obvious to have included with cswl.com - upnp-devices so that clients can find services across the Internet.


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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jeffrey D. Carlson  
Primary Examiner  
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jdc